

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

MMB Docket No. **1001-0700**

NCR Docket No.: **9236**

Application of: **Daniel F. White**

Group Art Unit: **3627**

Serial No.: **09/678,885**

Examiner: **Andrew J. Rudy**

Filed: **October 3, 2000**

Confirmation No.: **4770**

For: **Selective Omission of Transaction Data in a Digital Receipt**

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REPLY BRIEF

Hon. Commissioner of Patents and Trademarks

Alexandria, VA 20231

Sir:

In response to the Examiner's Answer, the Applicant replies with regard to the Examiner's allegation of a concession to the Official Notice and the extent of such concession.

ARGUMENT

In his Answer, the Examiner states that he has taken Official Notice that “retail terminals used with electronic cards has (*sic*) been common knowledge in the art.” *Answer*, p. 3, 3d paragraph. The Examiner then states that “[t]o have provided such for Rodriguez would have been obvious to one of ordinary skill in the art.” *Id.* The Examiner then concludes that because the Applicant has not traversed the Official Notice that the remarks made by Applicant regarding Rodriguez and retail terminals are arguments made regarding a point already conceded by the Applicant. As set forth below, Applicants submits that such a position is untenable in light of a properly construed concession.

The Official Notice taken by the Examiner is so broad that it cannot be reasonably traversed. Yes, Applicant concedes that one of ordinary skill in the art knows that retail terminals have been used with electronic cards. That concession, however, does not concede that the teachings of Rodriguez are immediately applicable to retail terminals as set forth in Applicant’s claims. Indeed, one of the arguments made by Applicant is that the card of Rodriguez provides the ability to edit data with mechanisms on the card so why would one of ordinary skill in the art modify a terminal to do what one can already do with the card of Rodriguez? The Examiner has not argued for a motivation to provide a retail terminal with the functionality that the Examiner claims is exhibited in the card of Rodriguez, but rather a motivation for “using retail terminals for its (*sic*) intended use.” The Examiner has failed to cite any evidence that the intended use of a retail terminal is to provide the functions of editing receipt data as required by the pending claims. Nothing is cited in Rodriguez that provides a clue that such editing is an intended use of a retail terminal. Consequently, Applicant has not conceded that the Official Notice and the teachings of Rodriguez arrive at the claimed invention. Therefore, Applicant’s opening brief argues that the Examiner has failed to show how the teachings of Rodriguez are applied to a retail terminal to arrive at Applicant’s claimed invention without recourse to Applicant’s specification.

The Examiner contends that the ability of the card in Rodriguez to enable a user to edit receipt information stored in the card somehow implies that coupling a retail terminal to the card of Rodriguez not only results in the receipt editing function migrating to the retail terminal, but in the transmission of the edited receipt to a device associated with the user *and* the storage of an unedited receipt in a merchant storage system. The Examiner bears the burden of proof to demonstrate how all of this functionality materializes because Applicant concedes that the prior art discloses a "retail terminal is used with an electronic card." Consequently, the Examiner's contention that Applicant has conceded the conjectured result of the Examiner's cited combination lacks objective support in the record and the section 103 ground of rejection should be reversed.

CONCLUSION

The Examiner has failed to present a prima facie case that claims 1, 4-6, 9 and 10 are obvious under 35 U.S.C. § 103(a) and, therefore, unpatentable over Patent Number 7,158,948 to Rodriguez. Applicant's concession on the vague and broadly worded Official Notice does not preclude consideration of Applicant's arguments that the cited reference and Official Notice fail to prove the Examiner's ground of rejection. The Board of Appeals, therefore, is respectfully requested to reverse the rejection of these claims.

Respectfully submitted,

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